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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,054	12/31/2001	Rajeev K. Nalawadi	42390P12867	9089
8791 7590 05/29/2007 BLAKELY SOKOLOFF TAYLOR & ZAFMAN 12400 WILSHIRE BOULEVARD SEVENTH FLOOR LOS ANGELES, CA 90025-1030			EXAMINER BAE, JI H	
			ART UNIT 2115	PAPER NUMBER
			MAIL DATE 05/29/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/039,054	<b>Applicant(s)</b> NALAWADI ET AL.	
	<b>Examiner</b> Ji H. Bae	<b>Art Unit</b> 2115	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely-filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 16 March 0207.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 16 March 2007 has been entered.

### ***Response to Arguments***

Applicant's arguments filed on 16 March 2007 have been fully considered but they are not persuasive.

Applicant has amended the claims to include the additional limitation of generating an SMI when a "complex task is encountered." Applicant further argues that Hobson teaches away from a complex task, asserting that Hobson merely teaches the detecting of whether a sleep enable bit is set.

With regards to applicant's "complex task", it is noted by the examiner that the applicant has provided a very open-ended definition of what might constitute a complex task. For example, on page 5, paragraph 16 of the originally filed specification, the applicant teaches that complex tasks "include, but are not limited to, handling and transferring large amounts of data that has to be gathered dynamically during runtime, saving and restoring devices coming out of suspend state, determining device standards, accessing features not accessible to the ASL code and so forth." Based on this, the examiner does not believe there is any reason to require that a complex task be limited to the exemplary tasks. Furthermore, apart from the cited portion

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of applicant's specification (which has already been demonstrated as being open-ended), the applicant has not provided any specific criteria for establishing the complexity of a task.

Additionally, the examiner refers to col. 5, lines 40-48 as an illustration of the task executed by the system of Hobson. The examiner believes that the applicant has oversimplified the nature of the task performed. Applicant's arguments state that Hobson merely teaches that the BIOS detects whether a sleep enable bit is set. However, the examiner points out that the process of sleeping includes, among other things, executing OEM routines for placing target devices into a proper state for remote manageability [col. 5, lines 40-42]. The applicant has narrowly defined that task as comprising only the setting of a bit, when Hobson clearly teaches that the process of sleeping involves a number of other steps. Applicant's open-ended definition of "complex task" provides no grounds for disallowing Hobson's sleeping process as being designated as a complex task. Furthermore, the process of transitioning to and from a sleeping state is at least implied by applicant's teaching that a complex task may comprise saving and restoring devices coming out of a suspend state.

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

Claims 13-18 recite a machine readable medium having stored therein a plurality of machine readable instructions; however, such a machine readable medium is not taught as being an embodiment of applicant's invention.

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***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding independent claims 1, 7, and 13, the claims each recite generating an SMI "when a complex task is encountered." Applicant's specification gives an open-ended definition for what may constitute a "complex task". For example, in the originally filed specification, pages 5 and 6, paragraph 16 states that complex tasks may "include, but are not limited to, handling and transferring large amounts of data that has to be gathered dynamically during runtime, saving and restoring devices coming out of suspend state, determining device standards, accessing features not accessible to the ASL code and so forth." Applicant's definition of "complex task" does not properly limit the scope of the claims, since according to applicant's specification, a complex task may comprise these exemplary tasks, as well as an unspecified set of addition tasks. Additionally, there is no specific criteria in applicant's specification for determining the complexity of a given task.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Hobson, U.S. Patent No. 6,122,748.

Regarding claim 1, Hobson teaches:

generating a SMI request under ACPI control when a complex task is encountered [col. 5, lines 35-48];

changing an operation mode of a processor to the SMM in response to the SMI request; and

executing a resume ACPI control process to return the processor to ACPI control after the process is complete [col. 5, lines 54-62].

Regarding claim 13, Hobson teaches the method of claim 1. Hobson also teaches the machine readable medium with instructions to implement the claimed method. Hobson also teaches that while in SMM, the processor executes tasks [col. 6, lines 60-64, configuring].

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3, 7-9, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hobson in view of Intel [Intel's SL Enhanced Intel486 Microprocessor Family, June 1993].

Regarding claim 2, Hobson teaches the method of claim 1, but does not teach saving processor state map information in a first area of a memory upon reception of the SMI request.

Intel teaches that upon generating an SMI, the processor saves the state of the system or SMRAM [page 2, "System-Level Power Management"].

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It would have been obvious to one of ordinary skill in the art to combine the teachings of Hobson and Intel by saving the processor state map information in a first area of memory, as taught by Intel. Hobson's disclosure teaches a processor transitioning between an ACPI control and an SMM, and teaches that exemplary processors include those from the Intel 80X86 family [col. 3, lines 40-42]. Since the disclosure of Intel is directed towards the same family of processors, it would have been obvious to one of ordinary skill in the art that the transitioning between ACPI and SMM would have been implemented in the manner taught by Intel.

Regarding claim 3, Hobson teaches setting SMI enable in a SMI generation register [col. 4, lines 14-18].

Regarding claims 7-9, Hobson and Intel teaches the method of claims 1-3. Hobson also teaches that while in SMM, the processor executes tasks [col. 6, lines 60-64, configuring]. Additionally, it would have been obvious to one of ordinary skill in the art to delegate tasks to various processors to achieve faster execution.

Regarding claims 14 and 15, Hobson and Intel teaches the method of claims 2 and 3. Hobson and Intel also teaches the machine readable medium with instructions to implement the claimed method.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ji H. Bae whose telephone number is 571-272-7181. The examiner can normally be reached on Monday-Friday, 10 am to 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Lee can be reached on 571-272-3667. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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